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13 SEP 2006

GENENTECH, INC.  
1 DNA WAY  
SOUTH SAN FRANCISCO CA 94080

In re Application of :  
AGGARWAL et al. :  
Application No.: 10/533,069 :  
PCT No.: PCT/US03/34381 :  
Int. Filing Date: 28 October 2003 :  
Priority Date: 29 October 2002 :  
Attorney Docket No.: P1982R1 :  
For: COMPOSITIONS AND METHODS FOR THE :  
TREATMENT OF IMMUNE RELATED DISEASES :

09/13/2006 SPASHEIR 00000005 070630 10533069  
DECISION  
01 FC:1463 200.00 DA  
02 FC:1617 130.00 DA

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 03 April 2006 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

**BACKGROUND**

On 28 October 2003, applicants filed international application PCT/US03/34381, which designated the United States and claimed a priority date of 29 October 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 13 May 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 April 2005.

On 28 April 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 03 January 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 03 April 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a declaration in support of the 37 CFR 1.47(a) petition by Barbara Hebert, copies of two letters sent to the non-signing inventor

Sudeepta Aggarwal by David A. Carpenter, a copy of a letter to Barbara Hebert from FedEx Express for details regarding a package shipped February 14, 2006, and a copy of a FedEx Track Shipments Detailed Results for a package shipped March 16, 2006.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 07-0630.

Item (2) has not been met. It is not clear whether it is being alleged that Sudeepta Aggarwal refuses to execute the application or that she cannot be reached after diligent effort. The two are distinct. *See, e.g.,* MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." A first communication was sent to Sudeepta Aggarwal on 14 February 2006. A second communication was sent to Sudeepta Aggarwal on 16 March 2006. The FedEx Track Shipments Detailed Results for the package shipped March 16, 2006 indicate that it was left at the front door of the indicated address. No indication is made whether a signature was obtained for the package mailed 14 February 2006. Accordingly, it is not clear if Sudeepta Aggarwal received the packages and did not respond or if she no longer resides there and her whereabouts are unknown. If it is being alleged that Sudeepta Aggarwal refuses to sign, the inventor must be presented with a complete copy of the application papers (specification, including claims, drawing, and oath or declaration) for a refusal to be established. Thus, if Sudeepta Aggarwal resides at the last known address, a complete copy of the application papers would still need to be presented to her. If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. *See* MPEP § 409.03, item I.

As to item (3), a clear statement of the last known address of the non-signing inventor has not been presented.

Item (4) has not been met. The declaration filed 03 April 2006 is not in compliance with 37 CFR 1.497(a)-(b). The declaration includes three page two's and three page three's. This suggests that all pages of the declaration were not present at the time of execution for each inventor, thus rendering the execution improper. A copy of the entire declaration submitted to applicant(s) for signing must be provided. Each executed declaration must identify all of the inventors and the citizenship of all of the inventors. Each submitted declaration must be complete, even if executed by only one of the inventors. It has been construed that the names Jill

Schoenfeld, as appears on the published international application, and Jill R. Schoenfeld, as appears on the declaration filed 03 April 2006, refer to the same person. If this interpretation is incorrect, applicants are required to notify the Office of PCT Legal Administration immediately. The surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage is required has been charged to Deposit Account 07-0630.

**CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
Daniel Stemmer

Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

Telephone: (571) 272-3301

Facsimile: (571) 273-0459